

REMARKS

By this amendment, claims 2, 3 and 9 remain withdrawn. Claim 1 has been amended. Claims 1, 4-8 and 10-20 remain in the application. Support for the amendments can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration and allowance of the application, as amended, is respectfully requested.

Rejection under 35 U.S.C. §103

CLAIM 1

Claim 1 recites a device having a first and a second sound-generating means and an input for a stereo signal comprising left and right sound signals, wherein the device has an interconnected first and second part comprising the first and the second sound-generating means, respectively, the first part being formed so as to couple soundwaves generated by the first sound-generating means into a surface when said device is placed upon said surface, wherein coupling soundwaves into the surface results in a co-vibrating of (i) the first sound-generating means and (ii) the surface to form (iii) a spatially extended source, and wherein the device has means for sending a first signal, being a first composite of the left and right sound signals, to the first sound-generating means of the first part, and a second signal, being a second composite of the left and right sound signals different from said first composite, to the second sound-generating means of the second part.

Support for the amendments to claim 1 can be found in the specification on at least page 3, lines 27-31; page 8, lines 23-27; and FIG. 2, as originally filed.

As presented herein, Claim 1 now more clearly articulates the novel and non-obvious distinct features thereof, as discussed below. The device as recited in claim 1 includes a first part in which a first sound-generating means generates soundwaves that are coupled into a surface on which the first part may be placed. As a result, the surface will be excited and vibrate with the sound generated by the first part. Stated another way, the surface co-vibrates with the first sound-generating means. (See the present specification on page 3, lines 27-34 and page 4, lines 1-6). The device of Claim 1 thus advantageously enables a stereo sound sensation to be provided to a listener over a relatively large area while being a compact sound reproduction device. In particular, a stereo sound impression is achieved which does not require the listener to be positioned in a particular spot or area.

Claims 1, 4-8 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Klayman** (US 5,784,468) in view of **Saitoh** (US 5,943,430). With respect to claim 1, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness ...*

It is submitted that, in the present case, the examiner has not factually supported a *prima facie* case of obviousness for at least the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Klayman** and **Saitoh** references cannot be applied to reject claim 1 under 35 U.S.C. §103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Klayman** nor **Saitoh** teaches a device featuring “first ... part comprising the first ... sound-generating means ... being formed so as to couple soundwaves generated by the first sound-generating means into a surface when said device is placed upon said surface, wherein coupling soundwaves into the surface results in a *co-vibrating* of (i) the *first sound-generating means and* (ii) the *surface to form* (iii) a *spatially extended source*” (emphasis added) as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

In contrast, **Saitoh** discloses a television stereophonic audio system in which reflection type directional intensifier speakers are provided on the right and left sides of the top of the television set for radiating sound diagonally forward and outward in relation to the CRT screen (see Saitoh, Abstract). In particular, the top speaker 31 of FIG. 2 is configured with its central axis pointing in a vertical direction and its diaphragm facing upward. Furthermore, “[d]irectional reflectors located *in front of* the diaphragms of each speaker are provided for reflecting sound waves in a horizontal direction” (emphasis added). (see Saitoh at col. 4, lines 55-61). The directional reflectors of Saitoh are thus not configured to co-vibrate with the diaphragm of the respective speaker. Accordingly, **Saitoh** neither teaches nor suggests a device featuring a “first ... part comprising the first ... sound-generating means ... being formed so as to couple soundwaves generated by the first sound-generating means into a surface when said device is placed upon said surface, wherein coupling soundwaves into the surface results in a *co-vibrating* of (i) the *first sound-generating means and* (ii) the *surface to form* (iii) a *spatially extended source*” (emphasis added) as is specifically recited in

claim 1.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Klayman** and **Saitoh** references cannot be applied to reject claim 1 under 35 U.S.C. §103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Klayman** nor **Saitoh** teaches, or even suggests, the desirability of the combination since no one of the references teach the specific device featuring a "first ... part comprising the first ... sound-generating means ... being formed so as to couple soundwaves generated by the first sound-generating means *into* a surface when said device is placed upon said surface, wherein *coupling* soundwaves *into* the surface results in a *co-vibrating* of (i) the *first sound-generating means* and (ii) the *surface* to form (iii) a *spatially extended source*" as specified above and as claimed in claim 1.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not

render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination presented in the Office Action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claims 4-8 and 10 depend from and further limit independent claim 1 and therefore are allowable as well. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

New Claims

New claims 11-20 have been added to provide for more complete claim coverage of the embodiments of the present disclosure. Support for new claims 11-20 can be found in the specification on at least page 3, lines 19-20 (localized source), 27-31 (co-vibrating, spatial source); page 4, lines 1-3 (stereo impression all around); 21-27 (co-vibrating, at least 6dB); page 5, lines 31-34 (swivel); page 6, lines 1-2, 17-19 (outer envelope, elongated element); page 8, lines 23-27 (co-vibration) and 31-32 (localized source); page 9, line 10-13 (stereo sound impression); page 10, lines 20-22 (15 dB, 20 dB), as originally filed. Claims 11-20 depend from and further limit, in a patentable sense, allowable independent claim 1, and therefore are allowable as well.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claim 1 is in condition for allowance. Claims 4-8 and 10-20 depend from and further limit independent claim 1 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 4-8 and 10-20 is requested.

Respectfully submitted,

/Michael J. Balconi-Lamica/

Michael J. Balconi-Lamica
Registration No. 34,291
for Edward Goodman, Reg. No. 28,613

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Philips Intellectual Property & Standards
345 Scarborough Road
Briarcliff Manor, New York 10510
Telephone: 914-333-9611
Facsimile: 914-332-0615
File: NL040025US1

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